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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/041,036	11/08/2001	James H. Silver	JSILVER.001CP1	3762

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EXAMINER

NASSER, ROBERT L

ART UNIT	PAPER NUMBER
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3736

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DATE MAILED: 01/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/041,036

Applicant(s)

SILVER, JAMES H.

Examiner

Robert L. Nasser

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,10,11,14-19,22-38 and 45-88 is/are pending in the application.

4a) Of the above claim(s) 31-38 is/are withdrawn from consideration.

- 5) ☒ Claim(s) 5,19,22-30 and 45 is/are allowed.
- 6) ☒ Claim(s) 1-7,10,11,14-18 and 56-88 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7. 6) ☐ Other: _____

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The examiner regrets that upon further examination, art was found to be applied to claims 1-7, 10, 11, and 14-18. Accordingly, the following non-final rejection has been applied. In addition, claim 22-26 recited that the sensors were on the radially inward side of the support structures, which was indicated allowable. However, claims 56-88 recite that the sensing surface is on the radially inward side of the sensor housing, which is not.

Claims 31-38 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 5.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 14 recites that the sheath is on the radially inward side of the lumen. This contradicts claim 1, which recites it is on the radially outward side of the lumen.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 56-88 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject

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matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. These claims recite that the sensing surface is on the radially inward side of the sensor housing. All the sensors disclosed have the sensing surface located behind a membrane and therefore there is no support for the claim limitation. Since this is a new limitation, it constitutes new matter. The art rejection will be revisited upon resolution of this issue. The examiner notes that reciting that the sensing surface is on the radially inward most side of the tubular support would still be allowable.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 10, 11, and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaplan in view of Jayaraman and Wilkins et al. Kaplan shows 2 stents, i.e. tubular supports, with a sensor 50 located therebetween. Kaplan does not have a sheath on the outer portion of the stents. Jayaraman teaches the use of such a sheath to minimize the strain on the blood vessel walls. Hence, it would have been obvious to modify Kaplan to use such sheaths, to minimize injury to the patient. In addition, the sensor of Kaplan only extends 100 micrometers, or 0.1 mm into the lumen. Kaplan teaches that any physiological sensor may be used with its device. Wilkins shows a sensor for

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implanting in a blood vessel that meets the limitations of claims 15-18, where the sensor has a thickness of 0.1mm to 5.2mm. It would have been obvious to modify Kaplan et al to use the sensor of Wilkins, as it is merely the use of one sensor used in a blood vessel for another. The combination has the remaining claim features.

Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaplan in view of Jayaraman and Wilkins et al, as applied to claims 1-4, 10, 11, and 15-18, further in view of Govari et al. The combination does not have a transmitter of a rechargeable battery. Govari shows a stent mounted sensor where the sensor has a transmitter for sensing information out of the body and a battery that is charged via an inductive link to the outside. Therefore, it would have been obvious to modify the above combination to sue the features of Govari, as it is merely the inclusion of known stent mounted sensor circuitry in the art.

Applicant's arguments filed 11/6/2003 have been fully considered but they are deemed moot in view of the new grounds of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert L. Nasser whose telephone number is (703) 308-3251. The examiner can normally be reached on Mon-Fri, variable hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (703) 308-3130.

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The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Robert L. Nasser
Primary Examiner
Art Unit 3736

RLN
January 26, 2004

